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Paper No. 4

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OFFICE OF PETITIONS

In re Application of
Covington et al.
Application No. 10/026,247
Filed: December 19, 2001
Attorney Docket No. 635482.625.036

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR § 1.47(a), filed July 1, 2002 (certificate of mailing date June 25, 2002).

The petition under 37 CFR. § 1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR. § 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR. §1.136(a).

The above-identified application was filed on December 19, 2001, without an executed oath or declaration. Accordingly, on January 28, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with § 1.63, and a surcharge for its late filing. This Notice set an extendable two-month period for reply until March 28, 2002.

In reply, applicant filed a petition, the surcharge for late filing of the declaration, and a partially executed declaration. To make the reply timely, a three (3) month extension of time was also submitted. In support of the petition, applicants submitted statement of facts and correspondence sent to the inventors.

A grantable petition under 37 CFR. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (2).

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR §§ 1.63 and 1.64 still has not been presented for the following reasons:

The first page of the Declaration does not list all joint inventors and the Declaration does not include page numbers --i.e. 1 of 2; 2 of 2. Instead the Declaration submitted

with the present petition identifies each inventor individually on a separate sheet paper without reference to the other joint inventors. The Declaration should set forth all of the joint inventors on the same page to ensure that each named inventor is aware of the other named inventors of the subject matter or indicate page numbers as outlined above.

Applicant submitted "Added Pages to Combined Declaration and Power of Attorney for Signature By Joint Inventor(s) On Behalf of Nonsigning Inventors Who Refuse to Sign or Cannot be Reached," which was only signed by joint inventor McGlone. However, 37 CFR § 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR §§ 1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.
(Emphasis added).

Here, applicants have indicated, by having inventor McGlone sign on behalf of the non-signing inventors, that the declaration as submitted is not signed by all the available joint inventors on behalf of themselves and on behalf of the non-signing joint inventors. A declaration properly executed by all available joint inventors on behalf of the non-signing inventors is required.

In addition, as to inventor Melanie Al-Shabkoun, applicant has failed to provide her mailing address on the declaration, as required by 1.63(c)(1).

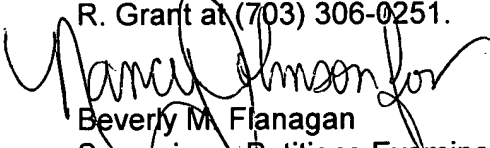
In addition, as to inventor John E. Kalil, his signature block includes non-dated/non-initialed alterations. Such alterations render the declaration unacceptable. The new declaration, executed by all available joint inventors on behalf of themselves and on behalf of the non-signing inventors should incorporate these changes or be properly dated and initialed by inventor Kalil. It is further noted that the deficiencies as to inventor Kalil are separate and distinct from the deficiency in execution discussed above. Accordingly, if applicants obtain a declaration executed by the non-signing inventors, a new declaration executed by inventor Kalil is still required.

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